

REMARKS

Applicant respectfully requests reconsideration of the previous rejection and requests that the finality of the last office action be withdrawn for the reasons stated below. MPEP 706.07(d) includes: “If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.”

Applicant also respectfully requests a telephone interview with the examiner and his SPE in the event that the examiner continues to maintain the rejection of all claims. Because it is in the best interests of applicant and the examiner that both have the case fresh in mind for an interview, and because applicant does not know when the examiner will reach this case for action, applicant requests that the examiner telephone the undersigned attorney to schedule a telephone interview a day or two later, so that applicant’s attorney will have an opportunity to review the application prior to the interview. An interview request form is appended hereto.

Preliminary Observation

In the last office action, paragraph numbered 5, the examiner referred to claim 1 as “sole independent claim.” However, claim 15 is also independent.

Why the finality should be withdrawn

The following are the reasons that the finality of the last office action should be withdrawn. They are also reasons which, in addition to the reasons stated in applicant’s

response of 29 October 2008, support the patentability of claims 1 and 15 and the claims dependent upon them.

1. MPEP 707.07(f) is entitled "Answer All Material Traversed" That section includes the statement "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The last office action did neither. The last office action did not take note of any argument made by applicant. The last office action did not answer the substance of the principal arguments made by applicant.

2. The most critical limitation in claim 1 is "the housing jacket (1) being an integral casting having a coating of the jacket inner faces including the channel internal walls via a cathodic dip-varnishing process". Similarly, in independent claim 15, one of the most critical limitations is "a coating on the jacket inner faces including the channel internal walls via a cathodic dip-varnishing process". In applicant's response to the first office action, applicant pointed out that the prior art does not show that. However, in the final rejection, the examiner cites **no** prior art showing any kind of coating on the internal passages of a coolable housing jacket for an electric motor. The examiner says only that he believes that the need for coating the fluid passages is notoriously old and well known in the art for anti-corrosion.

MPEP 2104.03 includes the relevant statements:

"Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the

examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))."

.....

"If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge."

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"If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.

Applicant respectfully submits that applicant's pointing out that this feature is not shown in the prior art was an adequate traverse of the examiner's assertion. In the first office action, the examiner did not mention that he was relying on what he believed was "well known in the art". Therefore, applicant did not cite this provision of the MPEP. As pointed out in the MPEP, a rejection based upon "well known in the art" should be rare when an application is under final rejection. "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." The MPEP further says "the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." That is not the case here. Therefore, this is not a proper rejection because it is not based upon the prior art. It is based upon what the examiner believes. The lack of such a reference and rationale for obviousness demonstrates that the claims should be allowed.

With respect to the "cathodic dip-varnishing process", the examiner cites Rentschler et al. that applicant agrees does teach a cathodic dip-varnishing process, which applicant conceded in its application was known prior art. The examiner describes that reference as being "in the

same field of endeavor”. But that reference has nothing to do with a coolable housing jacket for an electric motor. That reference also has nothing to do with internal passages. In fact it only mentions generally, as part of one sentence, that the pigment may be used “in the automobile industry, in watercraft construction and for the protection of buildings”.

3. In applicant’s last response, applicant pointed out that another important distinction from the prior art is that, in applicant’s invention, the coolant flow passages are in a single, unitary housing jacket 1. Applicant is unable to see anywhere in the final action that the examiner discussed that observation by applicant. Independent claim 15 recites that the cooling channels are within the integral housing. It does not say that just some channels are within the integral housing. It is obvious from the Katsuzawa drawings and applicant’s drawings that both housings have three components. The difference is that all the channels in applicant’s invention are in one “integral casting”. As pointed out in applicant’s last response, the cooling channel in the Katsuzawa reference are in three references. As also pointed out in applicant’s last response, applicant’s integral casting, in which the inner passages are formed, facilitates application of the internal protective coating, reduces the opportunities of coolant leakage and reduces the manufacturing and assembly costs. Since the final rejection did not address this important distinction that applicant described, that is another reason that the finality of the last office action should be withdrawn.

4. The most significant reason that the finality should be withdrawn and that claims 1 and 15 should be allowed is that there is no rejection which complies with the USPTO guidelines for a rejection. On October 10, 2007 in the Federal Register / Vol. 72, No. 195/ the USPTO published its *Examination Guidelines for Determining Obviousness Under*

35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.

Part II includes the statement “Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed.”

Part III of these Guidelines describes six different rationales for rejections labeled A - G. For each rationale, there are a series of findings. The list of findings for each rationale is preceded by the statement “Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:” Thereafter, for each rationale, the findings are listed. In other words, for each rationale for a rejection, the examiner must make a series of findings that form “an explanation to support an obviousness rejection”.

However, for the rejections of claims 1 and 15, there is no finding that coating the interior passages of a coolable housing jacket for an electric motor is known in the prior art. There is no finding that corrosion was a problem with the interior passages of a coolable housing jacket for an electric motor. There is no finding or explanation why it would have been obvious to use the cathodic dip-varnishing process to coat the internal passages of a coolable housing jacket for an electric motor. The rejection gives only the conclusory statements that it would be obvious to combine the references and that, if the references were combined, the result would be the invention.

Why the claimed subject matter is not obvious from the prior art

The reason the required findings, explanations and rationales are absent, is that the invention as claimed is not obvious from the prior art for the reasons stated in applicant's last response and as follows. This application should be allowed just as it was allowed by the European Patent Office.

Assume for purposes of this discussion that the examiner is correct in stating that: (a) all of the mechanical structures in the claims [the examiner's limitations (1) -(6)] are shown in Katsuzawa; and (b) Rentschler teaches a coating of cathodic dip varnishing process.

But the prior art does not show: (a) a coating of any kind on the internal coolant passages of a housing jacket for an electric motor; (b) a cathodic dip varnishing process used to coat any kind of internal passages; or (c) corrosion as a problem in the internal coolant passages of a housing jacket for an electric motor.

The prior art does not show the inner passages formed in one integral casting.

Because of the absence of these teachings in the prior art, it would not have been obvious to combine these references. What would lead the prior art worker to coat the internal passages of a housing jacket for an electric motor? What would lead a prior art worker to the cathodic dip varnishing process for coating those internal passages? Most importantly, what would lead a prior art worker to coat the internal coolant passages of a housing jacket for an electric motor with the cathodic dip varnishing process?

Similarly, what in the prior art would lead a worker of ordinary skill to put all the passages in one integral casting? What in the prior art would lead a prior art worker to recognize

that this structural feature facilitates application of the internal protective coating, reduces the opportunities of coolant leakage and reduces the manufacturing and assembly costs.

And even if these references were combined, the result of the combination would not be the invention according to claims 1 and 15. If these references were combined, one result might be to coat the external surface of the housing jacket or the external surfaces of the stator. There is nothing in the prior art, and no rationale based only upon the prior art, to lead a prior art worker to coat the internal coolant passages of a housing jacket for an electric motor with the cathodic dip varnishing process and to put those passages in one unitary casting to facilitate that process.

Therefore, applicant respectfully requests reconsideration, withdrawal of the finality of the last office action and allowance.

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,



23 January 2009
Date of Signature

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